

ESTTA Tracking number: **ESTTA22617**

Filing date: **01/05/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125743
Party	Defendant UGI HAVC ENTERPRISES, INC. ,
Correspondence Address	BARBARA L. DELANEY PEPPER HAMILTON LLP 3000 TWO LOGAN SQUARE EIGHTEENTH AND ARCH STREETS PHILADELPHIA, PA 19103-2799
Submission	Applicant/Respondent's Response to Opposer's Motion for Leave to File Amended Notice of Opposition and Amendment Petition for Cancellation
Filer's Name	Vincent V. Carissimi
Filer's e-mail	delaneyb@pepperlaw.com,deann@pepperlaw.com,hardyk@pepperlaw.com,wrightp@pepperlaw.com
Signature	/vincentvcarissimi/
Date	01/05/2005
Attachments	ugi001.PDF (4 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE SERVICEMASTER COMPANY,	:	
	:	
Opposer/Petitioner,	:	Opposition No.: 125,743
	:	Appln. Serial No. 76/237,328
	:	
v.	:	Opposition No.: 152,104
	:	Appln. Serial No. 76/166,568
	:	
	:	Cancellation No. 92/041,147
UGI HVAC ENTERPRISES, INC.	:	Registration No. 2,591,190
	:	
Applicant/Respondent.	:	

**APPLICANT/RESPONDENT'S RESPONSE TO OPPOSER'S MOTION FOR LEAVE TO FILE
AMENDED NOTICES OF OPPOSITION AND AMENDED PETITION FOR CANCELLATION**

Applicant/Respondent, UGI HVAC Enterprises, Inc. ("Applicant") pursuant to 37 C.F.R. § 2.127(a), files this Response to clarify the extent to which The ServiceMaster Company's ("Opposer") Motion for Leave would render moot Applicant's outstanding discovery were the Board to grant its Motion.

The Motion for Leave filed by Opposer represents the latest in a long line of moves made by Opposer designed to circumvent its discovery obligations. Neither Opposer's recent productions, nor its Motion for Leave, satisfy or render moot Applicant's outstanding discovery. The proposed amendment of Opposer's pleadings is the result of its abject failure to adduce any evidence to support its assertions rather than its disingenuous claim that it is motivated by a recent shift in the law of dilution.

Opposer claims that its Motion for Leave was precipitated by a "fundamental change in the law of dilution" pursuant to a Supreme Court decision decided since the filing of the instant proceedings but well before the present discovery dispute and Applicant's Motion to

Compel Discovery Responses. The decision cited by Opposer, *Moseley v. V. Secret Catalog, Inc.*, 65 USPQ2d 1801, 537 U.S. 418 (2003), was decided on March 4, 2003, a month after the present discovery dispute began with Opposer's February 4, 2003 discovery responses and 20 months prior to Applicant's November 3, 2004 Motion to Compel Discovery Responses.

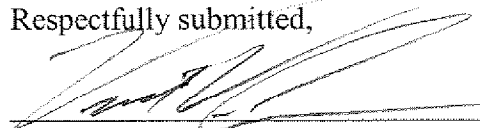
Opposer, by waiting 20 months to seek leave to amend its Notices of Opposition and Petition for Cancellation, has wasted Applicant's time and money and, more recently, taken up the Board's time by forcing Applicant to ask the Board to compel Opposer to respond to its outstanding discovery.

Opposer, in its Motion, has sought the Board's leave to eliminate its dilution claim and has indicated that it "will proceed solely on the legal theory of likelihood of confusion under Section 2(d) of the Lanham Act, including the factor of strength of the prior mark." The elimination of the dilution claim does not, therefore, render moot any of Applicant's discovery related to Opposer's likelihood of confusion claim, "*including the factor of strength of the prior mark.*" Applicant's discovery including, but not limited to, its discovery addressing the alleged use of Opposer's Mark in the fields of HVAC and plumbing, and the *strength* of the mark in those fields, remain relevant to Opposer's likelihood of confusion claim and would not be rendered moot by the elimination of the dilution claim.¹ If Opposer is granted leave to eliminate its dilution claim, Applicant will remain entitled to question whether, and, if so, to what extent, Opposer actually uses and/or plans to use Opposer's Mark on or in connection with the provision of HVAC and plumbing goods and/or services as claimed in Opposer's original *and* proposed Notices of Opposition of Petitions for Cancellation.

¹Applicant only concedes that Document Request No. 18 (First Set) calling for the production of "all documents and things which support Opposer's assertions that the SERVICEMASTER mark has achieved the status of a famous mark" would be rendered moot by Opposer's elimination of the its dilution claim.

In conclusion, while Applicant has chosen not to oppose Opposer's Motion for Leave, it is Applicant's position that Opposer's Motion has no impact on Applicant's Motion to Compel Discovery Responses other than as is detailed above.

Respectfully submitted,



VINCENT V. CARISSIMI
BARBARA L. DELANEY
Pepper Hamilton LLP
3000 Two Logan Square
Eighteenth & Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4000

Dated: January 5, 2005

Attorneys for Applicant/Respondent
UGI HVAC Enterprises, Inc.

CERTIFICATE OF SERVICE

I certify that on January 5, 2005, I caused a true and correct copy of the foregoing Applicant/Respondent's Response to Opposer's Motion for Leave to File Amended Notices of Opposition and Amended Petition for Cancellation to be served *via facsimile and first-class mail*, upon the following:

P. Jay Hines, Esquire
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314



NATHAN W. DEAN